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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHELL S. SIMPSON, WARD S. FOSTER,
and KRIS R. LIVINGSTON

Appeal 2009-001722
Application 09/712,308
Technology Center 2600

Decided:¹ June 17, 2009

Before ROBERT E. NAPPI, JOHN A. JEFFERY, and
KARL D. EASTHOM, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

ISSUES

Did Appellants demonstrate that the Examiner erred in finding that Maekawa teaches receiving a set of executable instructions from a printer as required by claim 1?

Did Appellants demonstrate that the Examiner erred in finding that Maekawa teaches executing by a client a set of instructions to generate a print job as required by claim 7?

FINDINGS OF FACT (FF)

Appellants' Disclosure

1. Appellants' "content" includes "WEB content," which may include a "non-exhaustive list" such as HTML code, JAVA script, JAVA Programs and C-"Sharp" code (Spec. 4:4-9). Appellants define "content": "Content. A set of executable instructions that is served by a server to a client and which is intended to be executed by the client so as to provide the client with certain functionality" (Spec. 4:4-7). Appellants also state: "Currently, the primary standard protocol for allowing applications to locate and acquire Web documents is HTTP, and the Web pages are encoded using HTML" (Spec. 4:28-30).

Maekawa

2. Maekawa states: "A printer controller unit 103 executes communication with and reception of image data from a host computer . . ." (col. 3, ll. 1-2). Similarly, Maekawa states: "The printer controller 103 effects communication with the host computer, reception of the image data .

..” (col. 4, ll. 55-56). External device 101 includes the host computer (col. 5, l. 67 to col. 6, l. 1).

3. Maekawa discloses sending status change signals from the printer to the host computer. In response to the status change signals, the computer 101 executes a responsive operation and displays the printer status. (Col. 7, ll. 9-27; col. 9, ll. 54-59).

PRINCIPLES OF LAW

“[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Under § 102, anticipation is established when a single prior art reference discloses expressly or under the principles of inherency each and every limitation of the claimed invention. *Atlas Powder Co. v. IRECO Inc.*, 190 F.3d 1342, 1347 (Fed. Cir. 1999); *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994).

Under § 103,

“there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). ““On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness” *Kahn*, 441 F.3d at 985-86 (citation omitted).

“It is the applicants’ burden to precisely define the invention, not the PTO’s.” *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997) (“The problem in this case is that the appellants failed to make their intended meaning explicitly clear.”).

ANALYSIS

As Appellants state, the Examiner found that Maekawa’s printer controller unit 103 in printer 102 executes communication with the computer 101 (*see* Reply Br. 3; Ans. 3-4). Further, Maekawa’s printer sends status signal data to the computer (FF 2, 3). The Examiner reasoned as follows:

While the status signal data itself does not constitute “executable instructions”, the effecting of communication of this status signal data from the printer to the host computer as described (column 3, lines 1-6; column 4, lines 55-61) inherently requires that the printer send at least one instruction (an instruction to begin receiving and processing data) which is executed by the host computer (which receives and processes the data).

(Ans. 5-6).

In response, Appellants state: “[S]uch an instruction is an instruction that *when executed by a computer causes the computer to receive the status signal data*” (Reply Br. 3) (emphasis added). Thus, Appellants do not dispute that Maekawa’s computer executes at least one instruction (to receive the status updates), generally as the Examiner reasoned. Such an instruction to receive the status updates eventually “cause[s]” the computer to respond by displaying a print status page - without the updates, no print status display “response” will occur (*see* FF 2, 3).

Appellants do not argue specifically that such “at least one” executable instruction as identified by the Examiner (Ans. 3-4) fails to

constitute a “set” of such instructions. Additionally, Maekawa’s printer, coordinating and thereby allowing the reception of different status data from the printer to the computer (FF 2), confers “certain functionality” to the computer, and thereby comports with Appellants’ disclosed use of the term “executable instructions” as including protocol and code for communicating (*see* FF 1).

“It is the applicants’ burden to precisely define the invention, not the PTO’s.” *Morris*, 127 F.3d at 1056 (“The problem in this case is that the appellants failed to make their intended meaning explicitly clear.”). Moreover, Maekawa’s printer sends updates, each with an implied executable instruction, to retrieve the updates, which are received by the host computer to process the updates and generate the print status display (*see* FF 2, 3). As such, two of such instructions constitute a set. It follows that Maekawa’s host computer “receiv[es] a set of executable instructions from a printer . . . to cause the computer to display a print status page . . . and . . . execut[es] the instructions so as to generate the print status page” as claim 1 requires.

Accordingly, Appellants have not demonstrated that the Examiner erred with respect to claim 1, nor with respect to claim 4, not separately argued. Appellants’ nominal arguments with respect to claim 13, and claims 14, 15, and 17 dependent therefrom, primarily rely on arguments presented for claim 1, which is similar in scope with claim 13. Thus, Appellants have also failed to demonstrate Examiner error with respect to claims 13-15 and 17.

With respect to claim 7, Appellants argue that “[t]he Examiner does not contend nor does Maekawa teach or suggest that a printer send

instructions to a computer such that when executed by the computer, the instructions generate and transmit a print job to the printer” (App. Br. 7-8). Claim 7 requires, in pertinent part: “transmitting, by the server, a set of executable instructions to a client, where the set of executable instructions is an agent of a particular printer . . . executing, by the client, the set of instructions to: generate a print job; transmit the print job to the printer” Appellants present a similar argument for claim 11, which is similar in scope to claim 7 (App. Br. 7-8).

The Examiner does not address the above arguments apart from merely reiterating the same position indicated with respect to claim 1 (Ans. 6-7) - a position that does not address the argued distinctions between claims 1 and 7. Further, the argued limitations are apparent neither in the Examiner’s Answer nor in Maekawa’s disclosure. Thus, the Examiner has not established a *prima facie* case of anticipation. As such, Appellants have demonstrated that the Examiner erred with respect to claims 7 and 11, and also claims 8-10 and 12 dependent therefrom.

With respect to the obviousness rejection of dependent claims 5, 6, 16, and 18, Appellants rely on arguments presented for claims 1 and 13 (App. Br. 8). Therefore, Appellants have not demonstrated error with respect to these claims.

With respect to the obviousness rejection of claim 19, and claims 20-23 dependent therefrom, Appellants rely on arguments for claim 1, repeat the limitations of claim 19, and assert that Maekawa fails to teach the limitations (App. Br. 8-9). Claim 19 appears similar in scope to claim 1. Appellants’ nominal arguments do not constitute separate arguments for patentability (*see* App. Br. 9). Therefore, based on our reasoning above with

respect to claim 1, Appellants have failed to demonstrate Examiner error in the rejection of claims 19-23.

CONCLUSION

Appellants did not demonstrate that the Examiner erred in finding that Maekawa teaches receiving a set of executable instructions from a printer as required by claim 1. Appellants did demonstrate that the Examiner erred in finding that Maekawa teaches executing, by a client, a set of instructions to generate a print job, as required by claim 7.

DECISION

We affirm the Examiner's decision rejecting claims 1, 4-6, and 13-23. We reverse the Examiner's decision rejecting claims 7-12.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

babc

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